

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael R. Schramm	§	Group Art Unit: 1713
Serial No.: 10/092,878	§	Examiner: Laura E. Edwards
Filed: March 6, 2002	§	Docket: MRS-017U
For: Spill-Proof Coloring Container	§	Conf No.: 2526

**RENEWED PETITION UNDER 37 CFR § 1.182 TO NULLIFY TERMINAL  
DISCLAIMERS**

Commissioner of Patents  
Alexandria, VA 22313-1450

This correspondence is being  
electronically transmitted to the  
patent office via an EFS-Web  
transmission on Oct 26, 2010.

Sir:

Applicant hereby files this renewed petition under 37 CFR § 1.182 requesting nullification of all terminal disclaimers filed in the instant application, specifically including the terminal disclaimer filed on January 24, 2005 which terminally disclaimed the statutory term of the instant application that would extend beyond the expiration date of the full term of US patent 6,386,138, the terminal disclaimer filed on September 19, 2005 which terminally disclaimed the statutory term of the instant application that would extend beyond the expiration date of the full term of US patent application 09/707,156, and the substitute terminal disclaimer filed on August 12, 2006 which terminally disclaimed the statutory term of the instant application that would extend beyond twenty years from the April 7, 1999 filing date of the 6,386,138 patent and twenty years from the November 6, 2000 filing date of the 09/707,156 patent application. Applicant requests application of the petition fee for a petition filed under 37 CFR § 1.182 that was transmitted with the original petition filed on April 7, 2010 to be credited against any petition fee required for this renewed petition.

Applicant notes that a decision by Senior Petitions Attorney Shirene Willis Brantley to dismiss the petition was mailed on September 20, 2010 (and for convenience forms appendix A of

this renewed petition). The decision provided no basis or reason for dismissing the petition. In a phone conversation between applicant and attorney Brantley, attorney Brantley explained that the decision to grant or dismiss the petition was in direct response to input by examiner Laura E. Edwards, and that in a phone message response to attorney Brantley by the examiner Edwards, examiner Edwards indicated that the petition should not be granted but that examiner Edwards provided no reason for requesting that the petition not be granted. Applicant notes that on October 12, 2010, applicant held an examiner's interview with examiner Edwards to determine examiner Edwards' reason for requesting that the petition be dismissed. In brief, examiner Edwards expressed her concern that there might have been a double patenting issue if the terminal disclaimers were nullified, but during the course of the interview, examiner Edwards agreed with applicant that the petition should be granted. Examiner Edwards' interview summary (as prepared by examiner Edwards) was mailed on October 19, 2010 (and for convenience, the last page of which forms appendix B of this renewed petition).

Applicant respectfully urges that this renewed petition should be granted for the following reasons. In the first instance, and contrary to the examiner's motivation to dismiss the petition, applicant urges that MPEP § 1490 part VII A, provides for the nullification of a terminal disclaimer and makes no exception for a potential "double patenting" rejection. Applicant urges that the potential for a double patenting rejection is not a valid reason to dismiss a petition to nullify a terminal disclaimer, rather the petition to nullify the terminal disclaimer should be granted and subsequently, if need, a double patenting rejection should be made. In the second instance, and as confirmed by the examiner during the examiner interview, there is no "double patenting" rejection that would need to be made even if the petition is allowed and the terminal disclaimers nullified. In the third instance, and contrary to the examiner's motivation to dismiss the petition, according to MPEP § 1490 part VII, inasmuch as the application has yet to issue as a patent, no portion of the potential patent term has yet been dedicated to the public because, *"the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer"*.

In summary, inasmuch as applicant has demonstrated that the petition as filed is proper and satisfies the requirements of MPEP § 1490 part VII A, and inasmuch as applicant has demonstrated that the examiner no longer holds the position that the petition should be dismissed and that the examiner's position is now of record, applicant respectfully requests that this renewed petition be granted and that the cited terminal disclaimers be nullified.

DATE: October 26, 2010

Respectfully submitted,

A handwritten signature in cursive script, reading "Michael R. Schramm".

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Michael R. Schramm

Reg. No. 56,441

Agent for the Applicant

801-710-7793



# APPENDIX A

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Michael R. Schramm  
350 West 2000 South  
Perry UT 84302

**MAILED**

**SEP 20 2010**

In re Application of	:	
Schramm	:	<b>OFFICE OF PETITIONS</b>
Application No. 10/092,878	:	
Filed: March 6, 2002	:	<b>DECISION ON PETITION</b>
Attorney Docket No. MRS-017U	:	

This is a decision on the petition filed April 7, 2010, requesting under 37 CFR 1.182 that the acceptance of the terminal disclaimers filed January 24, 2005, September 19, 2005, and August 12, 2006 be withdrawn. The \$ 400.00 petition fee has been received.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Petitioner is advised that this is not a final agency decision.

The Office of Petitions will not withdraw/nullify a terminal disclaimer filed in an application without the express approval of the examiner in charge of the application. The undersigned has consulted with the examiner in charge of this application, Laura Edwards. Ms. Edwards has indicated that the terminal disclaimers should *not* be nullified. Accordingly, the terminal disclaimers will not be withdrawn.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

By mail:	Mail Stop PETITIONS
	Commissioner for Patents
	Post Office Box 1450
	Alexandria, VA 22313-1450


# APPENDIX A

By hand: Customer Service Window  
Mail Stop Petitions  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

By fax: (571) 273-8300  
ATTN: Office of Petitions

By internet: EFS-Web  
[www.uspto.gov/ebc/efs\\_help.html](http://www.uspto.gov/ebc/efs_help.html)  
(for help using EFS-Web call the  
Patent Electronic Business Center  
at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

  
Shirene Willis Brantley  
Senior Petitions Attorney  
Office of Petitions

# APPENDIX B

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Telephonic response to a telephone call made by Applicant NOT to the Examiner but directly to SPE Nadine Norton to ascertain why the Examiner would direct petition personnel to deny the petition under 1.182 (filed 4/7/2010) to nullify all terminal disclaimers without reasoning.

Applicant was notified that in response to a general inquiry by petition personnel that the Examiner's opinion was given in the matter based upon the fact that all issues of double patenting had been dealt with by former Primary Examiner Lamb. All terminal disclaimers were approved in the record and there were no issues as to double patenting that went forward in the appeal process. Without scanning through the years of prosecution history and without there being clear logical reasoning for removing all terminal disclaimers, it would not be a good idea to reopen issues already closed. Applicant was reminded that the petition personnel has/had the authority to make the final decision as to the petition under 1.182 not the Examiner.

Applicant contended that the Examiner's opinion greatly influenced the petition decision and Applicant proceeded to direct the Examiner to MPEP 1490 to say that double patenting could be dealt with at any time in prosecution before the application became a patent.

Without further discussion on the MPEP, the Examiner looked at the prosecution history from the very beginning (office action as of 11/17/04) AND the prosecution history immediately following the decision by the Board of Appeals. In the office action of 11/17/04, no double patenting rejection was ever applied against claims 32, 44, or 46. Examiner Lamb indicated that claim 46 was allowable over the art of record in the same office action. In the communication (3/8/2010) following the Board decision, Examiner Lamb again noted that claims 32 and 44 needed to be placed in independent form [to be made allowable] while claim 46 was allowable. Since the Board of Appeals found that the combination in the kit of the container, workpiece, etc. to further include a flow channel in the wall of the container made the kit distinguishable over the prior art and no double patenting rejection was ever applied with respect to claims 32, 44, or 46 then it would not be fair to Applicant to stay the terminal disclaimers against those claims.

Applicant intends to file a renewed petition with reasoning as mentioned above as to why all terminal disclaimers should be withdrawn.